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10/541,097	01/10/2006	Carl R. VanderSchuit	9053V-000004/US/NPB	4259
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EXAMINER				
SAWHNEY, HARGOBIND S				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/541,097

**Applicant(s)**

VANDERSCHUIT, CARL R.

**Examiner**

HARGOBIND S. SAWHNEY

**Art Unit**

2885

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14, 44-46 and 50-70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14, 44-46 and 50-70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 June 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 2/5/2008.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The amendment filed on January 22, 2008 has been entered. Accordingly:
  - Claims 15-43 and 47-49 have been canceled;
  - Claims 1, 2, 50 and 51 have been amended; and
  - New claims 58-70 have been added.

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following claimed matter must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Claim 50 (amended), lines 12-15, "the member and the at least one LED are removably coupled ..... , thereby allow the at least one LED to be operated independently ..... and the base portion".

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for

Art Unit: 2885

consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 50-59 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 50 (Amended), 12-15, "the member and the at least one LED are removably coupled ..... , thereby allow the at least one LED to be operated independently ..... and the base portion" is neither properly described in the original specification nor shown in any of the figures.

The elements related to "the member coupled with at least one LED":  
described in the original specification include the following:

Para. 0016, "the base portion 12 is removably engaged with the socket extension 20";

Para. 0023 "the base portion supplies electrical power from the socket 13";

Para. 0026, "the base portion 12 includes a removable portion ";

Para. 0031, the LEDs 18 circumferentially spaced along the surface of the base portion 12"; and

Para. 0033, "an integrated circuit/printed circuit ..... positioned within the base portion 12";

As highlighted above, the specification does not support "the member and the at least one LED are removably coupled ....., thereby allow the at least one LED to be operated independently ..... and the base portion" claimed in the amended claim 50 and its dependent claims 51-57.

Therefore, the claimed "the member and the at least one LED are removably coupled ....., thereby allow the at least one LED to be operated independently ..... and the base portion" has been considered new matter, which is not supported by the specification.

Claims 51-57 are necessarily rejected because of their dependency on the base rejected claim 50.

Claim 58 has been rejected in similar manner as that applied to Claim 50 discussed above.

Claim 59 is necessarily rejected because of their dependency on the rejected base claim 58.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 3, 4, 9-12, 61 and 67 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No.: 6,756,893 B1 (Fernandez).

Regarding claims 1, 3, 4, 9-12, 61, 66 and 67, Fernandez discloses a lighting device (Figure 2) comprising:

- a base portion 12 removably engageable – capable of being engaged - to a light socket 4 (Figure 2, column 2, lines 3 and 9-11); Note: Fernandez teaches the base portion 12 being retrofitted – broadly interpreted as removably fitted- onto the existing socket.
- a socket – central cavity receiving a light bulb 5, and electrically connecting the base portion to the light bulb 5 (Figure 2, column 1, lines 31 and 32; and column 1, line 66);
- at least one light source 8 – a plurality of LEDs 8 – coupled to the base portion 12 (Figures 2 and 4, column 2, lines 5 and 6);
- the base portion electrically connected to at least one light source 8 – a plurality of LEDs 8 – providing power from the external existing light

- socket 4 to the at least one light source 8, and to the light bulb 5 (Figures 2-4, column 2, lines 12-17);
- the light bulb 5 being an incandescent bulb (Figure 2, column 1, line 66, and column 2, line 1);
  - a control circuit integrated in the base portion 12 and the light source 8 (Figures 1 and 2, column 2, lines 8-10); a switching device 13 allowing an off-mode to the LEDs (Figure 6, column (Figures 1, 2 and 6, column 2, lines 12-17);
  - at least one LED 8 producing light in one attribution – colored light – different than the light produced by the light bulb 5 (Figure 2, column 1, line 67; and column 2, lines 41-43);
  - a light-transmitting cover 3 enveloping the light bulb 5 (Figure 2, column 1, lines 65 and 66); the LEDs 8 operationally coupled to the circuitry enabling the LEDs presenting color changing (Fernandez, Figures 1 and 8-10, column 2, lines 41-44);

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 13 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez (US Patent No.: 6,756,893 B1).

Regarding claim 13, Fernandez discloses a lighting device (Figure 2) comprising a light transmitting cover receiving a light bulb, and the cover.

However, Fernandez does not specifically teach the light transmitting cover being removably engaged with the base portion.

It would be have been obvious to one of ordinary skill in the art at the time of the invention to realize the need of making the cover removably engaged for the benefits of replacement of lighting bulb needed for maintenance and operation of the device.

Regarding claim 58, Fernandez does not specifically teach the member being removably coupled to the base portion such that it allows the at least one light source to be independently operable – not a definite limitation -; from the light bulb.

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the lighting device of Fernandez by providing a removably coupled member , since it has been held that constructing a formerly integral structure in various separable elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179. The lighting device disclosed by Fernandez in view of Lee would function equally well with the provision of a removable member, and would impart enhanced operating capabilities.

9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No.: 6,756,893 B1 (Fernandez) in view of Japanese Patent No.: JP 11283415. (Tokawa et al.).



Fernandez discloses a lighting device comprising a light source with a cover. However, Fernandez does not specifically teach the light source being a black light source, and the cover including a portion responsive to the backlight.

On the other hand, Tokawa discloses a luminaire A including a black light source 2 with a cover responsive the black light emitted by the black light source 2 (Figure 1, English translated abstract) .

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the lighting device of (Fernandez)by providing a black light source with a cover having a portion responsive to black light as taught by Tokawa for the benefits enhancing utility of the device for various applications.

10. Claims 2, 7, 8 and 50-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No.: 6,756,893 B1 Fernandez in view of US Patent No.: 5,121,287 (Lee).

Regarding each of claims 2 and 16, Fernandez discloses a lighting device (Figure 2) comprising:

- a base portion 12 engageable to a light socket 4 (Figure 2, column 2, lines 3 and 9); and
- a socket – central cavity in the base portion 12 – adapted to receive a light bulb 5 (Figure 2, column 1, line 66).

However, Fernandez does not specifically teach the socket – the central cavity – adapted to receive a light bulb being a medium base socket.

On the other hand, Lee discloses an adapter for lamp control including a medium base socket 30 (Figures 1 and 2, column 1, lines 59-62, column 2, lines 6-9, and column 3, lines 11-19).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the lighting device of Fernandez by providing a medium base socket as taught by Lee for benefit and advantage of providing a lamp with low vertical profile desired for compactness.

Regarding claim 7, Fernandez discloses a lighting device (Figure 2) comprising a socket – central aperture – adapted to receive a light bulb 5 (Figure 2, column 1, line 66). However, Fernandez does not specifically teach the socket including a threaded portion receiving the threaded portion of the light bulb.

On the other hand, On the other hand, Lee discloses an adapter 30 for lamp control (Figures 1 and 2, column 1, lines 59-62 and column 2, lines 6-9) including a threaded socket 34 receiving the threaded portion 14 of the light bulb 16 (Figures 1 and 3, column 3, lines 11-19).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the lighting device of Fernandez by providing a medium base threaded socket including as taught by Lee for benefit and advantage of providing secured connection and quick and easy disconnection of a light bulb.

Regarding Claim 8, Fernandez in view of Lee discloses the lighting device further including the base portion 30 being removably engaged – threaded engagement- with the threaded portion (Lee, Figures 1-3, column 3, lines 11-19).

As best understood, regarding **claim 50**, Fernandez in view of Lee discloses the lighting device comprising:

- A socket 4'- the top portion - receiving the light bulb 5 (Figure 2, column 2, lines 2-5); a base portion 4'' – the middle portion carrying the element 12 (Figure 2) - engaging an existing light socket 4 for supplying power (Figure 2, column 2, lines 6-12); the base portion 4'' connected to the socket 4'' (Figure 2, column 2, lines 6-12); an annular member 12 having LEDs 8 and a central opening (Figure 2, column 12, lines 6-12); and the annular member 12 positioned around the light bulb 5 received in the central opening (Figure 2).

However, Fernandez does not specifically teach the socket including a threaded portion receiving the threaded portion of the light bulb.

On the other hand, Lee discloses an adapter 30 for lamp control (Figures 1 and 2, column 1, lines 59-62 and column 2, lines 6-9) including a threaded socket 34 receiving the threaded portion 14 of the light bulb 16 (Figures 1 and 3, column 3, lines 11-19).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the lighting device of Fernandez by providing a medium base threaded socket including as taught by Lee for benefit and advantage of providing secured connection and quick and easy disconnection of a light bulb.

Further, Fernandez does not specifically teach the member being removably coupled to the base portion such that it allows the at least one LED to be independently

operable – not a definite limitation; the member made capable of operating independently - from the light bulb.

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the lighting device of Fernandez by providing a removably coupled member , since it has been held that constructing a formerly integral structure in various separable elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179. The lighting device disclosed by Fernandez in view of Lee would function equally well with the provision of a removable member, and would impart enhanced operating capabilities.

Regarding claims 52-57, Fernandez in view of Lee discloses the lighting device further including:

- the base portion 4 connectable to the LEDs 8 (Fernandez, Figure 2, column 2, lines 6-12); the member 12 having a circular outer parameter and circular opening (Figure 2);
- the base portion 4” engageable- capable of- with the medium base socket in similar manner as that applied to claim 2 discussed above (Lee, Figures 1 and 2, column 1, lines 59-62, column 2, lines 6-9, and column 3, lines 11-19);
- a removable cover 3 – operationally required for replacement of the internals including the bulb, receiving the light bulb 5 and the LEDs 8 (Fernandez, Figure 2, column 1, lines 65 and 66); the external features of

the lighting device similar to that of an incandescent lamp (Fernandez, Figure 2).

11. Claims 5, 6 and 44-46, 51, 59, 60 and 68-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez (US Patent No.: 6,756,893 B1) in view of Diong et al. (US Patent No.: 5,349,330).

Regarding each of claims 5 and 51, Fernandez discloses a lighting device comprising a base portion engageable to a light socket. However, Fernandez does not specifically teach the base portion adapted to receive a power source for supplying back-up power to the light source.

On the other hand, Diong et al. ('330) discloses an illumination means (Figure 1) including an adaptor 11- base 11 including a power source 24 -, and batteries 24 supplying back-up power to the light source 15.

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the lighting device of Fernandez by providing an additional back-up power source – batteries - as taught by Diong et al. ('330) for benefit and advantage a redundant power source promoting high operational reliability.

Regarding claim 68, Fernandez in view of Diong et al. does not specifically teach the member being removably coupled to the base portion such that it allows the at least one light source to be independently operable – not a definite limitation -; from the light bulb.

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the lighting device of Fernandez in view of Diong et al. by providing

a removably coupled member, since it has been held that constructing a formerly integral structure in various separable elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179. The lighting device disclosed by Fernandez in view of Diong et al. would function equally well with the provision of a removable member, and would impart enhanced operating capabilities.

Regarding each of claims 60, 69 and 70, Fernandez in view of Diong et al. discloses a lighting device comprising a base portion bearing at least one LED and a light bulb, each connected to the battery positioned within the base portion as applied to claim 5, 44 or 50 discussed above.

It would be have been obvious to one of ordinary skill in the art at the time of the invention to realize that because the device, disclosed by Fernandez in view of Diong et al., including a battery, it is a stand alone, portable and self-contained when disengaged from the existing socket.

Regarding Claim 6, Fernandez in view of Diong et al. ('330) discloses the lighting device further including:

- the base 11 electrically connected to the power source 24 (Diong, Figure 1, column 2, lines 49-53) for recharging the backup power source.

Regarding claims 37 and 38, Fernandez in view of Diong et al. ('330) meets the limitations of the claims in the similar manner as detailed above for claims 5 and 6.

Regarding claim 44, Fernandez discloses a lighting device (Figure 2) comprising:

- a base portion 12 removably engageable – capable of being engaged – to

a light socket 4 (Figure 2, column 2, lines 3 and 9-11); Note: Fernandez teaches the base portion 12 being retrofitted – broadly interpreted as removably fitted- onto the existing socket.

- a socket – central aperture in the base portion 12 – adapted to receive a light bulb 5 (Figure 2, column 1, line 66);
- at least one light source 8 – a plurality of LEDs 8 – coupled to the base portion 12 (Figures 2 and 4, column 2, lines 5 and 6);
- the base portion 12 electrically connected to the socket and the at least one light source 8 – a plurality of LEDs 8 – providing power from the light socket 4 to the at least one light source, and to the light bulb (Figures 2-4, column 2, lines 12-17); and

However, Fernandez does not specifically teach the base portion adapted to receive a power source for supplying back-up power to the light source.

On the other hand, Diong et al. ('330) discloses an illumination means (Figure 1) including an adaptor 11- base 11 including a power source 24 – batteries 24 –supplying back-up power to the light source 15.

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the lighting device of (Fernandez)by providing an additional back-up power source – batteries - as taught by Diong et al. ('330) for benefit and advantage a redundant power source promoting high operational reliability.

Regarding claims 45 and 46, Fernandez in view of Diong et al. ('330) discloses the lighting device further including the base 11 electrically connected to the power

Art Unit: 2885

source 24 for recharging the backup power source 24 (Diong, Figure 1, column 2, lines 49-53).

12. Claims 62-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No.: 6,756,893 B1 Fernandez in view of US Patent No.: 5,561,346 (Bryne).

Regarding claim 62, Fernandez discloses the lighting device comprising a plurality of LEDs 8 arranged circumferentially about the socket receiving a light bulb as applied to claim 1 discussed in section 5 above. However, Fernandez does not specifically teach a second plurality of LEDs disposed on the side surface of the base member.

On the other hand, Bryne discloses a lighting device 10 (Figure 1) comprising a base surface 18 bearing a first plurality of LEDs 20 arranged on the side surface of the base portion 14 (Figure 1, column 3, lines 5-11).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the lighting device of (Fernandez) by providing the LEDs arranged as taught by Bryne for the benefits of providing large-flux LED light spread on larger area.

Regarding claims 63-65, Fernandez discloses a lighting device (Figure 2). comprising a plurality of LEDs mounted on the base as applied to claim 1 discussed in section 5 above. Fernandez further teaches the LEDs 8 directing light normal to the LED-bearing surface of the base portion.

However, Fernandez does not specifically teach at least one LED oriented for emitting light in one direction, and at least one LED oriented in a second direction other



than the first direction.

On the other hand, Bryne discloses a lighting device 10 (Figure 1) comprising a base surface 18 bearing a first plurality of LEDs 20 directing light in a first surface - normal to the LED-bearing surface - , and a second plurality of LEDs directing light in a second direction-substantially parallel to the horizontal direction – (Figure 1, column 3, lines 5-11).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the lighting device of (Fernandez) by providing the LEDs arranged as taught by Bryne for the benefits of providing LED light dispersed in normal and radial direction.

Further, it would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the lighting device of (Fernandez) by re-orienting some of the LEDs so that they direct light in a second direction other than the normal direction, since it has been held that rearranging parts of a prior art structure involves only routing skill in the art. *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950). The LED lighting device disclosed by Fernandez would function well with the LEDs re-oriented. for desired spread of light from the LEDs.

### ***Response to Amendment***

13. Applicant's arguments filed on January 22, 2008 with respect to the 35 U.S.C. 102(e) rejections of claims 1, 3, 4, 9-12, 33, 34, 39-41; and the 35 U.S.C. 103(a) rejections of claims 2, 5-8, 13, 14 and 44-57, have been fully considered but they are

Art Unit: 2885

not persuasive.

Argument:                Regarding amended independent claim 1, Fernandez does not teach the specially constructed socket for LEDs, which would also be removable.

Response:                The amended independent claim 1 does not include the limitation -- the specially constructed socket the LEDs be removable--. Actually, the amended claim 1 recites "a base portion removably engageable to the external existing light socket", which does not relate to the argued specially constructed socket the LEDs.

Argument:                Regarding independent claim 1 and 10, it is unclear whether the specially constructed socket includes a second jacket for receiving the light bulb.

Response:                The amended independent claim 1 does not include the limitation -- a second socket for a light bulb--. The amended claim 1 recites "a socket for receiving a light bulb"; and "at least one light source coupled to the base portion, which does not relate to the argued second socket. Further the amended claim 1 does not include any limitation reciting "the at least one light source received in a socket".

Argument:                Regarding amended independent claim 1, Fernandez does disclose the annular base removably engageable to the external

existing socket.

Response: As discussed in section 5 above, Fernandez teaches the annular base portion 12 being retrofitted – broadly interpreted as removably fitted- onto the existing socket.

Argument: The applicant disagrees that the central hole defined in base portion 12 is a socket.

Response: As clearly shown in Figure 2 of Fernandez, a light bulb 5 is received in the central hole defined in the base portion 12. Therefore, the central hole functions as bulb socket, which is well known in the art.

Argument: Regarding the amended claim 2 and dependent claim 54, the applicant is not aware of any automobile having an external lighting system with a medium base socket. Use of a medium base socket in the device disclosed by Fernandez would make the invention of Fernandez operationally unsatisfactory for its intended use.

Response: Mere statement "the applicant is not aware of any automobile having an external lighting system using a medium base socket" is not convincing. Further, the use of a medium base socket as taught by Lee imparts reasonable expectation of success, and would promote compactness for the device.

Art Unit: 2885

Argument:                Regarding each of the amended claims 44 and 50, Fernandez does not meet the amended limitation “the member and at least one LED are removably coupled to the base portion such that the member and the at least one LED are separable from the base portion, to thereby allow the at least one LED to be independently operable from the light bulb and the base portion”

Response:                As discussed in section 4 above, the amended limitation presents new matter. Further, Paragraph 0024 of the specification specifies possible removal of the device 10, which includes both the light bulb and light source, from the existing socket 13. Paragraph 0024 does not teach the limitation identified the applicant argued above.

Argument:                regarding claim 51, the limitation “at least one power source compartment for receiving at least one battery therein for applying power to the LED” Fernandez teaches the special circuit 12 that receives electrical power through wires passing through holes drilled through the existing socket 4.

Response:                The above indicated argument is not clearly understood. It appears that the applicant is questioning the implementation of a battery addition in the special circuit the member

Argument: "The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference.... Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). See also In re Sneed, 710 F.2d 1544, 1550, 218 USPQ 385, 389 (Fed. Cir. 1983) It is not necessary that the inventions of the references be physically combinable to render obvious the invention under review."); and In re Nievelt, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973) ("Combining the teachings of references does not involve an ability to combine their specific structures.").

The above discussed responses to the argument are equally applicable to the claims other than those identified above.

Thus, the prior arts applied in this office action and in previous office action(s) meet the limitations of all claims now pending this application.

### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Byrne (U.S. Patent No. 5,561,346)

Art Unit: 2885

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hargobind S Sawhney whose telephone number is 571 272 2380. The examiner can normally be reached on 8:30 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Jong-Suk (James) Lee can be reached on 571 272 7044. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

5/9/2008

/Hargobind S Sawhney/  
Primary Examiner, Art Unit 2885